

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

### REMARKS

The final Office Action, mailed June 6, 2005, considered and rejected claims 1-39.<sup>1</sup>

By this paper, claims 1, 13, 17-18 and 21 have been amended<sup>2</sup>, claims 3, 16, 19, 30 and 33-35 have been cancelled, and new claims 40-41 have been added, such that claims 1-2, 4-12, 14-15, 17-18, 19-29, 31-32 and 36-41 remain pending, of which claims 1, 13, 17 and 21 are the only independent claims at issue.

The present claims are generally directed to embodiments in which a hardware card (claim 1), a corresponding television tuning device (claim 13) and corresponding methods (claims 17 and 21) are utilized to enable a user to access EPG data other than EPG data the television tuning device was originally programmed to receive. In particular, embodiments of the invention utilize a hardware card containing data that is made available to the television tuning device and that enables the television tuning device to obtain Electronic Program Guide (EPG) information from various providers. In some embodiments, the data enables the television tuning device to access EPG information from a plurality of different providers.

In claim 1, for example, server, upon being connected to by the television tuning device, uses identification information obtained from the hardware card to determine a type of

<sup>1</sup> Claims 1-2, 4-5, 8, 10, 12, 30 and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takagawa et al. (U.S. Patent No. 5,987,612) in view of Nguyen et al. (U.S. Patent Application 2002/0010932). Claims 3, 6-7, 9, 11, 31-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takagawa et al. (U.S. Patent No. 5,987,612) in view of Nguyen et al. (U.S. Patent Application 2002/0010932) in further view of De Vito et al. (U.S. Patent No. 6,452,616). Claims 13-14, 17, 20, 34-35 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (U.S. Patent Application 2002/0010932) in view of Takagawa et al. (U.S. Patent No. 5,987,612). Claims 15-16, 18-19, 36 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (U.S. Patent Application 2002/0010932) in view of Takagawa et al. (U.S. Patent No. 5,987,612) in further view of DeVito et al. (U.S. Patent No. 6,452,616). Claims 21-25 and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria (U.S. Patent No. 6,405,369) in view of De Vito et al. (U.S. Patent No. 6,452,616) in further view of Nguyen et al. (U.S. Patent Application 2002/0010932). Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria (U.S. Patent No. 6,405,369) in view of De Vito et al. (U.S. Patent No. 6,452,616) in further view of Nguyen et al. (U.S. Patent Application No. 2002/0010932) in further view of Forrester (Can Sleepy Set-Top Boxes Ever Be Sexy?, Fall 1999, TBS Archives). Claim 27 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria (U.S. Patent No. 6,405,369) in view of De Vito, et al. (U.S. Patent No. 6,452,616) in further view of Nguyen et al. (U.S. Patent Application No. 2002/0010932) in further view of the U.S. Department of Justice (Undercover Customs Operation Results in Charges and Pleas in Connection with Stolen Satellite Television). Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria (U.S. Patent No. 6,405,369) in view of De Vito et al. (U.S. Patent No. 6,452,616) in further view of Nguyen et al. (U.S. Patent Application No. 2002/0010932) in further view of Cooper et al. (U.S. Patent No. 6,754,904). Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria (U.S. Patent No. 6,405,369) in view of DeVito et al. (U.S. Patent No. 6,452,616) in further view of Nguyen et al. (U.S. Patent Application No. 2002/0010932) in further view of Spies et al. (U.S. Patent No. 6,055,314).

<sup>2</sup> Support for the amendments to the claims are found throughout the specification and previously presented claims, including, but not limited to the cancelled claims, and paragraph 47 of the specification.

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

programming information that has been purchased by a consumer of the card, and thereafter enables the television tuning device to access the one or more electronic program guides, and which in some embodiments actually includes providing the EPG data (claim 40).

In other embodiments, such as in claims 13, 17 and 21, the data enables the television tuning device to obtain EPG data from a provider other than the provider that the television tuning device was originally configured/hard-coded to obtain EPG data from. This can occur, for example, by utilizing the data on the hardware card, which includes:

- an EPG decoding segment for each of the corresponding one or more electronic program guide providers, wherein each EPG decoding segment includes means for decoding encoded EPG information obtained from the corresponding one or more electronic program guide providers;

- a database segment having means for enabling transfer of the data onto the television tuning device; and

- a user interface segment which displays instructions corresponding to what a user must do to load the data on the television tuning device and to enable the television tuning device to access the one or more electronic program guides.

The data can also include information specifying to a user what the user must do to load, to the television tuning device, the data that enables the television tuning device to access the one or more electronic program guides (claim 31), such as having the user must enter a credit card number or an authentication code (claim 32).

Although the Examiner has cited numerous references (eight references) against the previously pending claims, Applicants respectfully submit that the currently amended claims are neither anticipated by, nor made obvious by, the cited art, when considered alone or in combination.

Initially, Applicants respectfully submit that primary references, Nguyen and Takagawa fail to disclose or suggest a hardware card that is utilized to enable a television tuning device to access EPG data other than EPG data the television tuning device was originally programmed to receive, in the manner claimed. In fact, Takagawa is not even directed to a television tuning device or an analogous art. Instead, Takagawa is directed to a computing system that provides automatically executed access to the Internet to automatically retrieve and process WWW information. (Summary)

Nguyen, on the other hand is directed to a tuning device for accessing program guides other than a program guide the device was programmed to receive. (paragraph 46). However,

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

Nguyen clearly fails to disclose or suggest that access to alternative program guides is provided through a hardware card, as claimed. Instead, Nguyen provides access to other electronic program guides in response to user input directed to a web browser. [47]. Nguyen also provides means for detecting and differentiating between input that is directed to the browser and program guide or a television function and for responding appropriately. [48]

Nguyen also discloses that the system can be configured to use smart cards [35]. However, Nguyen and Takagawa both fail, even in combination, to disclose or suggest that a server, upon being connected to by the television tuning device, uses identification information obtained from the hardware card to determine a type of programming information that has been purchased by a consumer of the card, and thereafter enables the television tuning device to access the one or more electronic program guides, as recited in claim.

Nguyen and Takagawa also fail, alone and in combination to disclose or suggest a method or system in which a hardware card includes:

- an EPG decoding segment for each of the corresponding one or more electronic program guide providers, wherein each EPG decoding segment includes means for decoding encoded EPG information obtained from the corresponding one or more electronic program guide providers;

- a database segment having means for enabling transfer of the data onto the television tuning device; and

- a user interface segment which displays instructions corresponding to what a user must do to load the data on the television tuning device and to enable the television tuning device to access the one or more electronic program guides;

as recited in the other independent claims 13, 17 and 21, and particularly when considering that the tuning device switches to another EPG provider than a particular EPG provider that the television tuning device is hard-coded to, **in response to accessing data on the hardware card.**

In view of the fact that the Examiner has cited so many references, and because some of the references appear to be directed to non-analogous arts, Applicants would like to remind the Examiner that the simple fact that something may be possible, does not make it obvious. In particular, the "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS." MPEP § 2143.01. This is true even all of the

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

elements are taught by the cited art, which they do not appear to be for at least the foregoing reasons.

Furthermore, Applicants also point out that with regard to any art or official notice that might be combined by the Examiner in any future rejection of this case, that the motivation for making such a combination must come from the references themselves, not the Applicant's own application, otherwise such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure." MPEP 2143. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)(emphasis added).

Even more particularly, to establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). Accordingly, "[i]n determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02. In light of these requirements, the prior art must illustrate specifically each limitation without improper combinations to show elements that simply do not exist in the cited references. In other words, it is improper to reject the claims as obviously stating what one of skill in the art might have done without specifically citing where such an element is disclosed. Obviousness may not be based on impermissible hindsight, using "knowledge gleaned only from applicant's disclosure." MPEP § 2145(X)(A).

In view of the foregoing, Applicants respectfully submit that there would be no motivation or suggestion provided in Nguyen and Takagawa to combine their teachings, even if they did disclose or suggest all of the claimed limitations of the independent claims, which they don't.

The only other independent claim rejected under other art is claim 21, which was rejected under Tsuria. However, it will be noted that Tsuria fails to disclose or suggest the use of a hardware card, as claimed that includes an EPG decoding segment, database segment and user interface segment, as claimed.

In view of the foregoing, the rejections of record are now moot, inasmuch as all of the independent claims have been distinguished from the art, and such that it is not necessary to address each of the other assertions of record in the last response. Nevertheless, Applicants

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

reserve the right to challenge any of said assertions in the future.<sup>3</sup> Accordingly, although the foregoing remarks are primarily directed to the independent claims, it will be appreciated that the dependent claims should also be found allowable over the art of record for at least the same reasons.

Although it is not necessary to individually address the rejections to each of the dependent claims at this time. Nevertheless, a few of the dependent claims will be addressed by the following remarks, as discussed during the interview, to even further distinguish the claimed invention over the art of record.

Claims 31 and 32, for example, relate to embodiments in which the hardware card further includes information specifying to a user what the user must do to load, to the television tuning device, the data that enables the television tuning device to access the one or more electronic program guides and wherein the information specifies that the user must enter at least one of a credit card number and an authentication code.

The Examiner has cited De Vito as purportedly teaching these things. However, the cited disclosure of De Vito (Figure 2) merely shows a user interface and which, according to the Examiner, "instructs a user how to access data on the smart card." Even if this were true, *arguendo*, Applicants respectfully submit that instructing a user how to access data on a smart card is different than specifying what a user must do to load data to a television tuning device, as claimed. Furthermore, with regard to requiring the user to enter at least one of a credit card number and an authentication code to load the information (claim 32), Applicants also submit that this is quite different than providing a password to unlock a parental lock, as referred to by the Examiner.

In view of the foregoing, Applicants respectfully submit that the pending claims are distinguished from the art of record, for at least the foregoing reasons and should now be considered in condition for allowance. If, however, the Examiner continues to reject the claims

---

<sup>3</sup> Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, because it is not necessary, for reasons described herein, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last response, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

Application No. 09/681,354  
Amendment "B" dated July 28, 2005  
Reply to Office Action mailed June 6, 2005

based on the same art, Applicants respectfully request that the Examiner cite to the portions of the art that would provide the requisite motivation for combining the art, particularly when considering that some of the art (Takagawa and Nguyen) appear to be directed to non-analogous art, or at least devices.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 2 day of Aug, 2005.

Respectfully submitted,



RICK D. NYDEGGER  
Registration No. 28,651  
JENS C. JENKINS  
Registration No. 44,803  
Attorney for Applicant  
Customer No. 047973

RDN:JCJ:ahm  
PPA0000000538V001